

REMARKS

This Amendment is responsive to the Office Action dated November 18, 2004. Claims 2-15, 17, 35 and 36 are pending in this case.

In the Preliminary Amendment of September 26, 2003, filed with the divisional application, Applicant added a paragraph indicating the parentage of the divisional application and claiming priority to its parent application, U.S.S.N. 09/982,365. Applicant's inserted paragraph referenced the incorrect filing date of October 21, 2001 for said parent application. The correct filing date for U.S.S.N. 09/982,365 should read as October 17, 2001. Applicant encloses a printout of the PAIR record for the parent application verifying the correct filing date, for the Examiner's convenience.

Applicant would initially like to thank the examiner for the indication of allowable subject matter in Claim 10. Claims 2-15, 17, 35 and 36 were rejected under 35 U.S.C. §112, first paragraph. Applicant has amended the claims and these amendments are believed to overcome the Section 112 rejections.

Claim 17 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 and 21, 31 and 32 of copending Application No. 09/982,365. Upon the issuance of the pending claims in the '365 Application, Applicant will timely file a terminal disclaimer to overcome the double patenting rejection.

Claims 2-7, 11-15, and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,632,042 to Liener Chin et al in view of Yankowski (5,751,672) and further in view of Hempleman et al. (6,243,725). Claim 10 is objected to as being dependent upon a rejected base claim, but the Examiner has indicated that it would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims. Applicant respectfully requests reconsideration of the claims as amended in view of the remarks presented below.

Rejections Under 35 U.S.C. §103(a)

The disallowed claims all stand rejected under §103 as being obvious over the cited art. In order to establish a *prima facie* case of obviousness, the Office Action must set forth three findings:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."
MPEP §706.02(j).

From the foregoing, no claim can be rejected under §103 unless each of the criteria are established by the Office Action. Because the rejection of Claims does not comply with these requirements as set forth below, the rejection of these claims is improper and cannot be sustained.

Claim 2

Claim 2 stands rejected in the Office Action as being obvious over Liener Chin et al. in view of Yankowski and Hempleman et al. Claim 2 is directed to an online method of organizing CD related materials comprising a number of recited steps. In order to establish a *prima facie* case of obviousness, one criteria that the Patent Office must establish is that each **step** is taught or suggested in the prior art.

Method steps such as at issue here should not be confused with apparatus claims requiring a structural difference. Rather, recited steps of a method claim must be compared to steps of a prior art reference. *Schumer v. Lab. Computer Sys.*, 308 F.3d 1304, 1309 (Fed. Cir. 2002) ("[A] method claim will be anticipated by an earlier device performing all of the operative **steps** of the method) (emphasis added).

In rejecting Claim 2, the Office Action states that,

"a recitation of the intended use of the claimed invention **must result in a structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art."
[Office Action, pp. 6 - 7] (emphasis added).

Applicant respectfully submits that the Office Action's assertion that a method claim must demonstrate a "structural difference" in order to be patentable is incorrect. Rather, as set forth above a method claim is a series of steps and a *prima facie* case of obviousness requires that those identical steps be taught or suggested in the prior art.

For example, Claim 2 includes the limitation of "selecting a display binder including a plurality of loose leaf sheets, including respective pockets having transparent viewing panels and respective identifying indicia uniquely associated therewith" followed by **"inserting the respective compact disc related materials into said pockets having said identifying indicia."** [Claim 2]. It also includes the limitation of "assigning positional identifiers correlating the respective said identifying indicia to the respective titles of said collection of titles" which in turn were acquired from an online database. These steps are part of the disclosed method of organizing a large collection of compact disc related materials using an online database. Rather than demonstrate that these **steps** were taught by the prior art, the Office Action attempts to demonstrate that apparatus existed in the prior art that might be possible for carrying out the recited steps of Applicant's novel method.

The Office Action primarily relies on the teachings of Liener Chin et al. to demonstrate the recited steps, yet Liener Chin has nothing to do with an online method of organizing a large collection of compact disc related materials. Rather, Liener Chin et al. is directed to a protector system for a printed sheet. [Abstract].

It is respectfully submitted that the Office Action cannot establish obviousness of recited steps by pointing solely to apparatus that might be used to carry out the invention, as confirmed by the Supreme Court. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 422 (U.S. 1902) ("[A] process patent can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process might have been performed").

None of the references cited by the Office Action teach or suggest "assigning positional identifiers correlating the respective said identifying indicia to the respective titles of said collection of titles" where the collection of titles is derived from "selecting from said [online] database the title of said compact disc titles to provide a collection of titles." Again, the Office Action only attempts to show apparatus that *might be used* to carry out the recited steps, but not the steps themselves. Under longstanding precedent, this is a wholly improper methodology for analyzing method claims.

Moreover, the Office Action attempts to overcome the admitted shortcomings of the Liener et al. reference by combining the teachings of Liener et al. with the teachings of Yankowski. At page 6, the Office Action states that Yankowski discloses an online database admittedly missing from the primary reference, and concludes without support that,

"it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Liener Chin et al.'s method of organizing with an online database as taught by Yankowski **for providing a means to generate a particular listing.**"

As stated above, an essential requirement of a *prima facie* case of obviousness is a "suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The Federal Circuit has repeatedly held that this showing of a motivation to combine the references is **critical**, and necessary to demonstrate the examiner did not use hindsight and the Applicant's disclosure in selecting the prior art references. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000). That is why,

"when patentability turns on the question of obviousness, the search for and analysis of the prior art includes **evidence** relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. **The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record.**" *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

Here, there has been no "thorough and searching" inquiry as to the motivation to combine the references as proposed by the Office Action. In fact, there is not even an attempt by the Office Action to demonstrate that the prior art teaches the proposed modification. Instead, the Office Action **merely concludes** without support that the proposed combination would have been obvious. If the stated criteria of showing a motivation to combine could be established by merely stating "it would have been obvious ... " without any reference to anything in the prior art itself suggesting the benefits of the proposed modification, then the criteria would have no weight whatsoever. The Federal Circuit has consistently rejected this approach, and required a clear demonstration in the prior art suggesting the proposed combination. Because such

proposed suggesting has not been identified here (certainly there is no literal connection between the teachings of Yankowski and the teachings of Liener et al.), Applicant submits that a *prima facie* case of obviousness has not been established and the obviousness rejection of Claim 2 must be withdrawn.

Claims 3 - 4

The Office Action failed to address Claims 3 and 4. Claim 3 includes additional limitations not taught or suggested in the prior art, such as "assigning said selected compact disc title a positional identifier matching said identifying indicia." This **step** is not found anywhere in the cited prior art, as no cited prior art even addresses the organization of CD information. For the reasons set forth at length above, Claims 3 and 4 are patentably distinguishable over the cited art and should be passed to allowance.

Claim 5

The Office Action once again recites the requirement of a structural limitation to demonstrate that **method** Claim 5 is not patentably distinguishable over the cited art. As set forth above, the requirement of structural differentiability is not part of the analysis of a method claim, which must be compared to steps (not structure) of the prior art. Because the Office Action concedes that the step of Claim 5 is not found in the cited art, Applicant respectfully submits that Claim 5 is properly allowable.

Claim 6

The Office Action failed to address the limitations of Claim 6, and Applicant submits that Claim 6 is allowable for the reasons addressed above.

Claim 7

The Office Action once again improperly uses principles of analyzing an apparatus claim to reject the **method** claim 7. The Office Action states "it has been held that mere duplication of the essential working parts **of a device** involves only routine skill

in the art." [Office Action, p. 7]. However, Applicant does not claim a **device** but rather a set of steps to carry out a recited method. Because the recited step of Claim 7 is distinct from other recited steps, it is incumbent upon the Office Action to identify the teaching or suggestion of this distinct step in the prior art and demonstrate why using this step would have been obvious to one of ordinary skill in the art. The Office Action fails to even identify this step in the recited art (thereby precluding an obviousness rejection), and does not even attempt to show where in the prior art the proposed modification of the Liener et al. reference incorporating "searching a remote database for a resulting compact disc title and adding said resulting compact disc title to said master listing." Accordingly, the rejection of Claim 7 is respectfully submitted to be improper and should be withdrawn.

Claim 8

Claim 8 further limits the method organizing "compact disc related material" where the disc related material is liner notes. Consistent with the arguments presented above, Applicant submits that there has been no teaching in the prior art for carrying out the inclusive steps of Claim 8. The Office Action concedes that its proposed combination of Liener Chin et al., combined with Yankowski, further combined with Hempleman et al. still fails to teach all the claimed limitations of Claim 8. The Office Action attempts to overcome the deficiency by adding yet another reference to the mix, arguing that Ho supplies the missing step. However, the Office Action once again fails to demonstrate **why** one of ordinary skill in the art would have been compelled to search for another reference and why Ho would have been selected. The Office Action cites to nothing in the prior art suggesting the benefits of combining Ho with the other references, and only the Applicant's disclosure can reasonably be identified as the impetus behind the proposed combination. However, it is impermissible to use the Applicant's disclosure as a mosaic to piece together various elements of the prior art without some teaching in the prior art to suggest the proposed combination. The failure of the Office Action to identify a "thorough and searching" inquiry into the reasons for the proposed combination

show that impermissible hindsight has been used to invalidate the claim, and the rejection of Claim 8 is properly withdrawn.

Claim 9

The remarks presented with respect to Claim 8 are applicable here and are incorporated by reference.

Claims 11 - 15

The Office Action states that the "mere claiming of storage of facts or data ... does not impart patentability." Again, the claimed method recites a step in said method that does not claim "the mere storage of facts or data" but rather recites a step on the claimed method of organization of compact disc materials. Because the Office Action does not identify any prior art references that teach this claimed step, it is improper to suggest that the claimed step is not patentable - particularly when the Applicant is not claiming an apparatus for data storage but rather a method of organizing materials. In addition to the arguments presented with respect to Claim 2, the rejection of Claims 11 - 15 based on the improper conclusion that a claimed step in a CD organization method is obvious based on existing structure for data storage is improper and should be withdrawn.

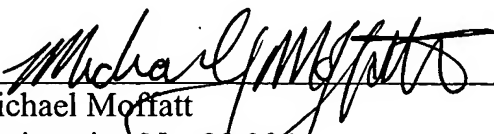
Claims 35 - 36

The arguments above are directly applicable to the rejection of Claims 35 and 36, wherein the Office Action has failed to identify the recited steps in the cited prior art. Further, the Office Action ignores the criteria of establishing a motivation to combine the respective prior art teachings, relying instead on unsupported conclusory statements that the Office Action's proposed modifications would have been obvious to one of ordinary skill in the art. Applicant respectfully submits that the Office Actions rejection of the claims based on 35 U.S.C. §103(a) fails to establish a *prima facie* case of obviousness as required by §706.02(f) of the MPEP, and must be withdrawn.

In view of the foregoing remarks, Applicant submits that the claims are in condition for allowance and early notification of same is respectfully solicited. If the examiner believes that a telephone conference will further the prosecution of this case, she is kindly invited to contact the undersigned at the number below.

Respectfully submitted,

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